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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,805	02/08/2002	Mark Setteducati	1473	2847

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EXAMINER

SUHOL, DMITRY

ART UNIT

PAPER NUMBER

3712

DATE MAILED: 04/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/071,805

**Applicant(s)**

SETTEUCATI, MARK

**Examiner**

Dmitry Suhol

**Art Unit**

3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 11-15, 18 and 19 is/are rejected.
- 7) ☒ Claim(s) 7-10, 16, 17 and 20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/18/04</u> . | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Claim Objections***

Claims 3 and 19 are objected to because of the following informalities: The claims are missing a period at the end thereof. Appropriate correction is required.

Claims 13-17 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 4-8, respectively. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

It appears as if the dependency of claim 13 may be improper (e.g. claim 13 is currently dependent from claim 1, however it appears as if applicants may have intended to have claim 13 depend from claim 11). It should be noted that if the dependency of claim 13 is changed to claim 11, applicant should be cognizant that the term "the drawing surface" found in claims 16 and 17 would lack antecedent basis.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5-6, 14-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 5 and 14, the metes and bounds of the claim language encompassed by the phrase "...the cap member has a profile of a hat" can't be determined. Hats come in a great variety of sizes and shapes (i.e. top hat, baseball hat, knit cap...) therefore the physical features the applicants are attempting to claim are not clear.

Regarding claims 6 and 15, the metes and bounds of the claim language encompassed by the phrase "...the base member has a profile of a collar" can't be determined. Collars come in a great variety of sizes and shapes (i.e. lay-down collar, wing collar, mandarin collar...) therefore the physical features the applicants are attempting to claim are not clear.

The remainder of the claims are considered as best understood.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 11-15 and 18-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Whitney '627. Whitney discloses a deformable drawing tablet containing all of the elements of the claims including, a series of individual elongated strips (elements 2) as required by claims 1, 11 and 18, means confining the strips together

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(elements 3 thru 6) as required by claims 1, 11 and 18, a drawing surface (an image carrying surface as required by claim 11) as required by claims 1 and 18 is shown in figure 3 where it is considered that since the surface has a drawing on it then the surface is a drawing surface, strips moving by sliding over each other (cols. 1-2, lines 49+ and 1-3, respectively) as required by claims 2, 12 and 18, a lateral edge being formed by respective longitudinal ends of the strips (figures 1-3) as required by claims 3 and 18, the strips being formed from longitudinally extending slots (figure 5) as required by claims 4, 13, the confining means comprising a post extending transversely of said strips through said slots (elements 3 and 6) in a longitudinally sliding relationship therewith (figure 5 and cols. 1-2, lines 49+ and 1-3, respectively) as required by claims 4, 13. A cap member, as required by claims 4, 5, 13 and 14, is read onto element 5. A base member, as required by claims 4, 6, 13 and 15, is read onto element 4. Regarding claim 19, the examiner takes official notice that it is known that a wooded material can be marked/drawn upon with an erasable ink tool.

### ***Allowable Subject Matter***

Claims 7-10 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 703-305-0085. The examiner can normally be reached on Mon - Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read 'Derris H. Banks', with a long horizontal line extending to the right.

DERRIS H. BANKS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700